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Date: November 6, 2001

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Docket No. YAMAP0575US

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PATENT

JAN 07 2002

Technology Center 2600

In re Appellant:

M. Shoji, et al.

Serial No: 09/089,901

Art Unit: 2651

Filed: June 3, 1998

Examiner: Aristotelis Psitos

For: OPTICAL DISK APPARATUS AND METHOD FOR SETTING CONTROL
PARAMETERS

REPLY BRIEF

Honorable Commissioner of
Patents and Trademarks
Washington, DC 20231

Dear Sir:

Appellants hereby submit this Reply Brief, in triplicate. The Examiner's Answer was mailed on September 10, 2001. Accordingly, Appellants' Reply Brief is timely filed within the two month period provided in 37 C.F.R. of § 1.193(b)(1).

RESPONSE TO EXAMINER'S ARGUMENT

Regarding claims 1 and 11, the Examiner asserts that the recording technique described at Col. 12, lines 35-55 of *Moriya et al.* considered together with the acknowledged prior art JP 4-141827 meets the limitations of the claims. While it may be correct that the elements of the claims may be found in the prior art, Appellants respectfully disagree with the conclusion that it would have been obvious to make the asserted combination/modification of the cited references and therefore traverse this rejection.

At pages 7-8 of the Examiner's Answer, in response to Appellants' arguments, the Examiner basically reiterated the selected disclosures of the cited references, and reiterated the conclusion that it would have been obvious to have "the control parameters changed at the end of the recording/reproducing session when one comes to the end of the continuous recording/reproducing of the land-groove track, and not at the end of each segment."

The Examiner failed to identify any disclosure in the cited references which would provide a motivation for making the asserted combination/modification of the teachings of the references.

At page 4 of the Examiner's Answer, in the statement of the rejection, the Examiner asserted the "motivation is to use the above parameter setting ability with as many different types of records as possible, and hence increase the overall system use." This asserted motivation appears to be "that knowledge generally available to one of ordinary skill in the art" referred to by the Federal Circuit in *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). However, like the examiner and the Board in *Kotzab*, the present Examiner's asserted motivation "lacks the necessary substantial evidence to support a rejection of [Appellants'] claims." *Id.*

As set forth in *Kotzab*, "more than a mere scintilla of evidence is necessary to support" the conclusion that it would have been obvious to make the asserted combination/modification of the cited references. *Id.* There is not such relevant evidence as a reasonable mind might accept as adequate to support the conclusion. *Id.*

As in *Kotzab*, the idea of an optical disk apparatus comprising, *inter alia*, "a controller for changing the control parameter set by the control parameter set by the control parameter setting unit; repeating the recording and reproduction performed by the recording and reproduction unit and detection performed by the detector every time the control parameter is changed, and determining the control parameter based on the quality of the signal detected by the detector" as recited in claim 1, and a step for performing this function as in claim 11, may be a technologically simple concept, in hindsight. However, Appellants submit that, as in *Kotzab*, the motivation asserted by the Examiner at page 4 of the Examiner's Answer fails to rise to the level of setting forth "the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Appellants' invention to make the combination in the matter claimed." *Id.* at 1318. The asserted motivation is merely a "broad conclusory statement standing alone" which is not the "evidence" required in support of an asserted motivation. *Id.* at 1317, quoting *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Accordingly, Appellants respectfully submit that the Examiner has failed to state a case of *prima facie* obviousness of the invention claimed in claims 1-20.

CONCLUSION

For the foregoing reasons, and for the reasons set forth in Appellants' Appeal Brief, reversal of the rejection of Appellants' claims 1-20 as lacking support is

respectfully requested. Appellants respectfully request reversal of the Examiner's rejections under Section 103.

The Office is authorized to charge any under payment, or to credit any overpayment, in connection with this Appeal to Deposit Acct. No. 18-0988.

Respectfully submitted,
RENNER, OTTO, BOISSELLE & SKLAR

November 6, 2001
Date

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